

### REMARKS

This application has been reviewed in light of the Office Action dated November 30, 2005. Claims 23, 26-34, and 37-48 are now presented for examination, of which Claims 23, 34, 45, and 46 are in independent form. Claims 24, 25, 35, and 36 have been canceled, without prejudice or disclaimer of subject matter. Claims 23, 34, 39, 45, and 46 have been amended to define more clearly what Applicant regards as his invention. Claims 47 and 48 have been added to provide Applicants with a more complete scope of protection. Favorable reconsideration is requested.

An Information Disclosure Statement and a corresponding Form PTO-1449 were filed on November 20, 2005. Applicants respectfully request the Examiner to return an initialed copy of the Form PTO-1449, indicating the reference cited therein was considered.

Claims 23-46 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,073,142 (Geiger).

First, cancellation of Claims 24, 25, 35, and 36 renders the rejections of those claims moot.

Applicant submits that independent claims 23, 34, 45, and 46, together with the remaining claims dependent thereon, are patentably distinct from the cited prior art for at least the following reasons.

Claim 23 is directed to a communication apparatus which is connected to an E-mail server via a network. A receiving unit is adapted to receive an E-mail which is to be sent to the communication apparatus, stored in a mail box provided on the E-mail server. A first obtaining unit is adapted to obtain attribute information of the E-mail stored

in the mail box. A discriminating unit is adapted to discriminate whether or not to receive the E-mail before the receiving unit receives the E-mail, based on the obtained attribute information. In a case where the discriminating unit discriminated to receive the E-mail, the receiving unit receives the E-mail that the discriminating unit discriminated to receive. A controlling unit is adapted to, in a case where the discriminating unit discriminated not to receive the E-mail, send to the E-mail server an instruction for deleting from the mail box the E-mail that the discriminating unit discriminated not to receive. In a case where a plurality of E-mails are stored in the mail box, after the controlling unit sends to the E-mail server an instruction for deleting the E-mail that the discriminating unit discriminated not to receive, or after the receiving unit receives the E-mail that the discriminating unit discriminated to receive, the discriminating unit further discriminates whether or not to receive an E-mail other than the E-mail that the discriminating unit discriminated not to receive.

Notably, in accordance with an aspect of the communication apparatus of Claims 23, before receiving an E-mail stored in a mail box provided on the sending side connected to the communication apparatus through a network and to be received by (or addressed to) the communication apparatus, it is discriminated whether or not to actually receive the relevant E-mail. If it was discriminated to receive the E-mail, the E-mail that the communication apparatus discriminated to receive is received. If it was discriminated not to receive the E-mail, the mail box of the sending side is sent an instruction for deleting from the mail box of the sending side the E-mail that the communication apparatus discriminated not to receive. If a plurality of E-mails have been stored in the mail box of the sending side, after sending the instruction for deleting the E-mail that the

communication apparatus discriminated not to receive, or after receiving the E-mail that the communication apparatus discriminated to receive, it is further discriminated whether or not to receive an E-mail other than the above E-mail that the communication apparatus discriminated not to receive.

By virtue of the features of Claims 23, it is possible to prevent the situation in which a user is not aware that the communication apparatus is in a state incapable of receiving the E-mail due to the memory being full. It is also possible to prevent the situation in which a user cannot learn how many non-receivable E-mails still remain in the E-mail server of the sending side. Moreover, it is possible to execute together the discriminations as to whether or not to receive the E-mails to be received by the communication apparatus. For this reason, after executing the relevant reception discrimination, it is possible to execute together the receptions of the E-mails that the communication apparatus discriminated to receive.

More specifically, according to an aspect of the invention to which the communication apparatus of Claim 23 relates, if the E-mail that the apparatus discriminated to receive is actually received, the reception process ends. On the other hand, in regard to the E-mail that the apparatus discriminated not to receive, the instruction for deleting this E-mail is issued from the communication apparatus to the E-mail server of the sending side so as to dispense with the reception process, on the side of the communication apparatus, in regard to the E-mail that the communication apparatus discriminated not to receive based on the communication apparatus itself, and so the reception process ends. Subsequently, the reception discrimination process and the reception process are likewise executed to another E-mail.

In this way, the communication apparatus can, as soon as it ends the reception discrimination process and the reception process for one E-mail, execute the reception discrimination process for another E-mail and then proceed with the reception process to the discriminated E-mail. For this reason, in the communication apparatus, once the reception process of the E-mail stored in the E-mail server of the sending side starts, the reception discrimination process and the reception process of the E-mail stored in the E-mail server of the sending side and to be received by the relevant communication apparatus automatically end.

Consequently, in the apparatus of the invention relating to Claim 23, all of the E-mails that the communication apparatus does not receive are deleted from the E-mail server of the sending side after a series of reception processes are ended, whereby all of the E-mails that the communication apparatus does not receive do not remain in the E-mail server of the sending side. Thus, it is possible to reduce the load of the E-mail server of the sending side. Further, it is possible to prevent the unnecessary operation whereby the E-mail server of the sending side again executes the sending process of the E-mail that the communication apparatus of the reception side discriminated not to receive, and the unnecessary operation whereby the communication apparatus of the reception side again executes the reception process of the E-mail that the relevant communication apparatus discriminated not to receive. Furthermore, it is possible to prevent the situation in which the E-mail server cannot receive a new E-mail because a large number of E-mails have already been stored in the relevant E-mail server. In addition, if the reception discrimination process and the reception process for the E-mail are sequentially executed, thereby ending these processes while the communication apparatus is operating in an

unattended state (namely, in the state that the user is away from the operating communication apparatus), a user wishing to use the relevant communication apparatus can use it immediately.

Geiger, as understood by Applicant, relates to a system which, for example, transfers, deletes and returns an E-mail according to a business rule in the gate keeper of an automatic mail system. More specifically, as shown in FIG. 4A, in the REPO (Rule Enforcing Post Office) 102, after the E-mail is received from the sending side by the receipt engine 200 (Step 404), an action (decided based on the size of the E-mail, the number of attachments and the like) for the E-mail message is applied by the rule engine 210 (Step 412), and the E-mail as a resulting is deleted if the rule decides on deletion (Step 422). That is, Geiger discusses deleting the E-mail which is not transferred from the REPO 102 to another destination.

However, in Geiger, even the E-mail which has been discriminated not to be sent or transferred to another terminal is once received from the sending side (see Step 404), and the received E-mail is once stored in the same terminal and then deleted therefrom. Applicant notes that, in Geiger, the GPO (Gatekeeping Post Office) 106 and the GKADMIN (Gatekeeper Administration) 108 have the same constitution as that of the REPO 102.

Applicant submits that the REPO 102, the GPO 106, or the GKADMIN 108 in Geiger cannot anticipate the communication apparatus of Claim 23, since the communication apparatuses in Geiger do not have the constitution of instructing the sending side to delete an E-mail, and also do not have the constitution of discriminating whether or not to receive the E-mail before actually executing the E-mail reception process.

Accordingly, since Geiger merely discusses the constitution of executing the reception process even for the E-mail to be deleted in the event, a communication error occurs in such a case as the reception process cannot be executed due to the memory of the communication apparatus being full. In other words, since the deletion of the E-mail cannot be instructed to the sending side, the E-mail which is not sent unnecessarily remains on the sending side indefinitely. As a result, it is impossible in Geiger to reduce the load of the E-mail server of the sending side. Further, in Geiger, since the reception process and the reception discrimination process do not end, the reception process is repeated many times. In this connection, of course, the sending process is repeated many times on the sending side. Accordingly, the communication apparatus in Geiger cannot proceed to the reception discrimination process and the reception process for an E-mail other than the E-mail discriminated not to be received.

In addition, even if, assuming *arguendo*, it is the Examiner's position that the destination to which the E-mail is delivered from the REPO 102, the GPO 106, or the GKADMIN 108 (such destination hereinafter being referred to as the reception terminal) corresponds to the communication apparatus of Claim 23, the reception terminal in Geiger does not have the constitution of instructing the sending side of the E-mail to delete the relevant E-mail, and also does not have the constitution of discriminating whether or not to receive the E-mail before actually executing the E-mail reception process.

In other words, Geiger does not have the constitution that a deletion instruction is sent from the reception terminal to the sending side, but has the function of deleting the E-mail on the sending side. In Geiger, the sending side discriminates whether or not to delete the E-mail according to the rule set on the sending side (that is, the

convenience on the sending side). Here, it is assumed that the sending side discriminates not to delete the E-mail and then actually sends to the reception terminal the E-mail discriminated to be sent to the relevant reception terminal. In that case, if the reception terminal is in a state incapable of receiving the E-mail due to the memory being full, the reception terminal cannot receive the E-mail even though it was permitted by the sending side to receive the E-mail. On the other hand, since the sending side already discriminated to send the E-mail, it is impossible to delete the relevant E-mail and end the sending process of the relevant E-mail, whereby the relevant E-mail which cannot be sent remains on the sending side indefinitely.

That is, it is impossible in Geiger to reduce the load of the E-mail server of the sending side. Further, in Geiger, on the sending side, since the sending process of the E-mail does not end although the relevant E-mail has been discriminated to be sent, the sending process is repeated many times. In this connection, the reception process of the E-mail is repeated many times on the reception side although the relevant E-mail cannot be received any more. Thus, the communication apparatus in Geiger cannot proceed to the reception discrimination process and the reception process for an E-mail other than the E-mail discriminated not to be received.

Nothing in Geiger would teach or suggest the above-described features of Claim 23, and thus it is impossible in Geiger to achieve the above-described significant advantages of the present invention.

In particular, nothing in Geiger would teach or suggest a communication apparatus in which (a) a receiving unit receives an E-mail which is to be sent to the communication apparatus, stored in a mail box provided on the E-mail server, and (b) a

discriminating unit discriminates whether or not to receive the E-mail before the receiving unit receives the E-mail, and if the discriminating unit discriminated to receive the E-mail, the receiving unit receives the E-mail that the discriminating unit discriminated to receive, and as set forth in Claim 23. Neither does that reference teach or suggest (c) a controlling unit adapted to, if the discriminating unit discriminated not to receive the E-mail, send to the E-mail server an instruction for deleting from the mail box the E-mail that the discriminating unit discriminated not to receive, in which if a plurality of E-mail is stored in the mail box, after the controlling unit sends to the E-mail server an instruction for deleting the E-mail that the discriminating unit discriminated not to receive, or after the receiving unit receives the E-mail that the discriminating unit discriminated to receive, the discriminating unit further discriminates whether or not to receive an E-mail other than the E-mail that the discriminating unit discriminated not to receive, as recited in Claim 23.

Accordingly, Claim 23 is believed to be patentable over Geiger et al..

Independent Claims 34, 45, and 46 each recite features that are similar in many relevant respects to those discussed above with respect to Claim 23 and therefore are also believed to be patentable over Geiger et al. for at least the reasons discussed above.

A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as a reference against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of

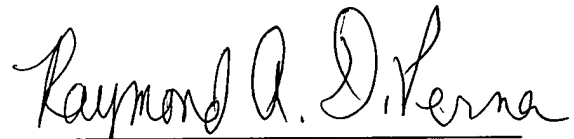


the invention, however, the individual consideration or reconsideration, as the case may be, of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in cursive script, reading "Raymond A. DiPerna". The signature is written in dark ink and is positioned above a horizontal line.

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